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| 10/501,701 | 05/05/2005 | Thomas J. Nosker | 70439.00026 | 7140 |
| 29880 7590 03/04/2011 FOX ROTHSCHILD LLP PRINCETON PIKE CORPORATE CENTER 997 LENOX DRIVE BLDG. #3 LAWRENCEVILLE, NJ 08648 | | | | |
| EXAMINER | | | | |
| MULLIS, JEFFREY C | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1765 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary

Application No.

10/501,701

Applicant(s)

NOSKER ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1765

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4 and 11-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 12/295574. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicants characteristic is assumed inherent given that all other limitations are present in copending claim 14.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3, 4 and 11-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Leclair in Fig. 4 on page 4725 discloses an SClair 59 C HDPE/M-2500 polycarbonate blend wherein use of applicants' proportions result in a modulus which is the same or even substantially less than the additive contribution of the components indicating that applicants have not enabled production of compositions with the claimed characteristic of a modulus greater than the additive contribution of each polymer.

Note Casey in Table II indicating that SCLAIR 59C has a melt Index of only 0.40. Note Kieser indicating (third "IT" entry in the abstract) that "M 2400" polycarbonate is "Makrolon 2400". Note Krishnan at the paragraph bridging columns 3 and 4 where use of MAKROLON 2400 is disclosed and note the paragraph bridging columns 5 and 6 where injection molding is disclosed. Note Chung at column 3, lines 46-53 where use of MAKROLON 2400 is disclosed and note column 4 lines 23-27 where injection molding

is disclosed. Note Boyd at column 3, lines 40-65 where use of MAKROLON 2400 is disclosed and note column 2, lines 25-55 where injection molding is disclosed. Casey, Kieser, Krishnan and Chung therefore indicate that Leclairs individual comports read on those of the instant claims. It is noted that applicants figures show modulus vs composition curves for various compositions. However there is no detail in the specification regarding the specific materials used except that they pertain to ABS, HDPE and polycarbonate (for instance specific melt flow rates, ABS rubber content, type of polycarbonate etc) nor is the method of actually forming the blends disclosed. While possibly many of these factors have no bearing on forming blends with applicants characteristics it can not be concluded that any blend showing positive deviation from the law of mixtures in the figures can be said to have applicants characteristics nor is it clear how to choose materials to produce blends having applicants characteristics given the disclosure of Leclair.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, 4 and 11-24 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Applicants invention wherein the mixture of polymers provides a blend having a "modulus greater than the additive contribution of each polymer to overall stiffness" is inoperative as blends with applicants

materials in applicants proportions do not appear to have such a characteristic as set out above in Leclairs' Fig. 4.

Claims 1, 3, 4, 7 and 11-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Figure 5 shows a small portion of the composition range barely meeting applicants characteristic requirements those skilled in the art would not assume that applicants were in possession of the concept of compositions having applicants "additive contribution" characteristic for other melt flow rates besides those associated with the materials of Figure 5 or for the specific range of concentrations shown in the figures. Applicants combination of limitations regarding melt flow, concentrations, use of "injection molding grade ABS" or mixtures of "injection molding grade PC and ABS mixtures" and "additive contribution" are therefore new matter an claims 1, 3, 4, 7 and 11-22. With regard specifically to claims 23 and 24 admittedly only blends in which the modulus is greater than those of each polymer are being claimed. Therefore the only issue is use of "injection molding grade" ABS and

mixtures. However, the specification as filed does not disclose that the ABS to be used (alone or in admixture) in applicants blends is "injection molding grade".

US 2007/0082995 and 2002/0099160, previously cited of interest disclose MFR data at paragraphs 92 and 158 respectively for various polycarbonates.

Applicant's arguments filed 12-3-09 have been fully considered but they are not persuasive.

The examiner agrees that support exists for "injection molding grade PC" and this limitation is not new matter nor would claims 1 and 15 contain any new matter if limited solely to PC and HDPE, although the issue of enablement in view of the disclosure of Leclair, newly cited above is another matter. However with regard to the limitation that the PC/ABS mixture is injection molding grade or that ABS is injection molding grade, applicants argument that this limitation is supported by the specification as filed is based on the allegation that the ABS containing articles disclosed by the specification as filed are "known to one of ordinary skill in the art to be injection molded from ABS". While it is may be true that many if not all of the recited articles are described somewhere in the prior art in some cases as being derivable by injection molding, absent any understanding by those skilled in the art that at least one articles disclosed must be derivable from injection molding it can not be said to be inherent in the disclosure as filed that the ABS to be used is injection molding grade. Otherwise the specification as filed could have just as well as disclosed "non injection molded" versions of the articles as disclosed in paragraph 15 of the instant specification without any contradiction. The examiner has reviewed applicants exhibits. However, there is nothing in applicants

specification which would cause those skilled in the art to believe that applicants characteristic was due to use of viscosity grades of ABS associated with injection molding grades of ABS especially since the articles at paragraph 15 could have just as well (at least in some cases) been produced by other molding methods besides injection molding. Furthermore there is nothing in applicants exhibits indicating what range of melt flows are viewed as injection molding grade ABS but rather only single values of melt flows are disclosed for specific materials. Applicants argue that the claims have been limited to use of ratios of polymer grades producing the disclosed results. However at present it is not entirely clear that use of the specific viscosity material implied or specifically recited by the claims will produce applicants characteristic and it is not even clear that use of any particular viscosity will inevitably lead to applicants results in view of Leclair cited above given that Leclair uses materials in a form having applicants viscosities. Admittedly Leclair does not produce blends containing the specific individual materials of instant claims 4 and 23. However, given that applicants teach the equivalence of ABS and PC for producing immiscible blends with a modulus higher than predicted from the law of mixtures would lead those skilled in the art when viewing applicants specification to question whether the feature responsible for applicants characteristic in PC/HDPE blends was also responsible for the characteristic in HDPE/ABS blends or to question whether blends with equivalent materials (ie ABS rather than solely polycarbonate) would work to produce the claimed result..

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis
M-F, 9-5 pm at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1765

JCM

2-27-11

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1765